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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,059	05/11/2006	Hirofusa Shirai	127928	1379
25944 7590 02/26/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER SZNAIDMAN, MARCOS L				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
02/26/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/579,059

**Applicant(s)**

SHIRAI ET AL.

**Examiner**

MARCOS SZNAIDMAN

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/IC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 3 pages / 05/27/08 and 05/11/06



### **DETAILED ACTION**

This office action is in response to applicant's reply filed on January 5, 2009.

#### ***Election/Restrictions***

Applicant's election with traverse of Group IV (Claims 23-29) in the reply filed on January 5, 2009 is acknowledged. The traversal is on the ground(s) that the phthalocyanines of formula I (see claim 1) or formula II (see claim 2) are not special technical features because the common technical feature goes well beyond the metal phthalocyanine alone: the special technical feature includes an "allergen decomposer" common to independent claims 1, 6, 11, 15, and 23 in which the allergen decomposer comprises the metal phthalocyanine derivative recited by the same. JP A-61-258806, relied upon by the Office Action, does not suggest an allergen decomposer comprising a metal phthalocyanine derivative. Rather, in the Abstract, JP A-61-258806 only discloses a polymeric material with semipermanent deodorant function. The polymeric material carries metallic phthalocyanine.

Examiner's response: This is not found persuasive because the term "allergen decomposer" is considered an inherent property of the metal phthalocyanine derivative and does not add any new limitation to the claim (see a detailed discussion below in the 102 (b) rejection).

The requirement is still deemed proper and is therefore made FINAL.

Applicant's election with traverse of the species: metal phthalocyanine tetracarboxylic acid is also acknowledged. Applicant's arguments are persuasive, so the election requirement is withdrawn. Consequently all species corresponding to the general structure of formula II (see claim 23) are being considered.

### ***Status of Claims***

Claims 1-29 are currently pending and are the subject of this office action.

Claims 1-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 5, 2009.

Claims 23-29 are presently under examination.

### ***Priority***

The present application is a 371 of PCT/JP04/04445 filed on 03/29/2004.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in JAPAN on 11/12/2003 and 11/17/2003. It is noted, however, that applicant has not filed a certified copy of the 2003-382565 and 2003-387100 applications as required by 35 U.S.C. 119(b).

***Claim Rejections - 35 USC § 102***

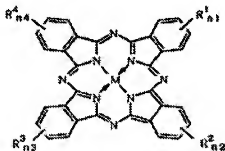
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawakami et. al. (WO 2001/41689).

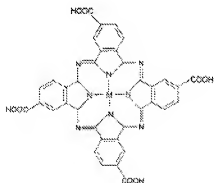
Claims 23 and 24 recite an antiallergenic fiber material carrying an allergen decomposer as an active ingredient, wherein the allergen decomposer comprises a metal phthalocyanine derivative represented by the following formula:



wherein (see claim 24) the metal phthalocyanine derivative is selected from the group consisting of a metal phthalocyanine dicarboxylic acid, tetracarboxylic acid, octacarboxylic acid, disulfonic acid, tetrasulfonic acid, octasulfonic acid, carboxylate thereof, and a sulfonate thereof. Claim 26 further limits claim 23, wherein the metal phthalocyanine derivative is 0.1% to 10% mass% of fiber weight. Claim 27 further limits claim 23, wherein a raw material for fiber material is selected from the group consisting of: cellulose fiber, cotton, hemp, etc. Claim 28 recites an antiallergenic fiber product

comprising the antiallergenic fiber material of claim 23. Claim 29 further limits claim 28, wherein said product is selected from the group consisting of cloth, bedding, curtain, wallpaper, etc.

For claims 23-29 Kawakami teaches an odor reduction layer comprised of fibers like nonwoven webs, tissue webs, and synthetic or natural fibers like cellulose fibers, etc (see page 8, second paragraph) carrying metal phthalocyanine derivatives with the following preferred general structure:



Wherein the central metal (M) is Ni, Fe, Co, Mn, Cu or Zn. Preferred metal phthalocyanine derivatives have -COOH as the functional group. Such preferred metal phthalocyanine derivatives can have either di, tetra or octa forms of -COOH. Alternatively, the metal phthalocyanine derivatives can have any form selected from the group consisting of mono to octa forms of -SO<sub>3</sub>Na (see page 7, line 15 through page 8, line 5). In a preferred embodiment, the odor reduction layer contains about 0.3% of the metal phthalocyanine material, and about 99.7% of the carrier (fiber). The material can be used in disposable diapers (a type of baby cloth) (see page 18, second paragraph until page 29).

The statements: "antiallergenic fiber material" in claims 23-27 or "antiallergenic fiber product" in claims 28-29 are considered intended uses and do not add any new limitation to the claims. *Catalina Mktg. Int'l, Inc. V. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (fed. Cir. 2002). "The recitation of a new intended use (antiallergenic) for an old product (a fiber material comprising a metal phthalocyanine) does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

While the prior art does not specifically characterize the metal phthalocyanines as being "allergen decomposers", the claimed limitation does not appear to result in a manipulative difference between the prior arts composition because as evidenced by the specification: metal phthalocyanines act as allergen decomposers by coordinating the protein to the central metal atom of the phthalocyanine, and then the peptide is cut in lower molecular fragments by oxidation with Oxygen (see end of page 7, beginning of page 8). As such, the claimed composition appears to be the same as the prior art. MPEP 2112 I states: "The discovery of a previously unappreciated property (allergen decomposers) of a prior art composition (fiber material carrying a metal phthalocyanine), or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer". *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).



***Conclusion***

No claims are allowed.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/579,059

Page 8

Art Unit: 1612

/MARCOS SZNAIDMAN/  
Examiner, Art Unit 1612  
February 23, 2009

/Brandon J Fetterolf/

Primary Examiner, Art Unit 1642